

REMARKS

These remarks are in response to the Office Action mailed April 21, 2008. Claims 1-4 have been amended. Support for the amendments can be found throughout the specification as filed (see, e.g., paragraph [0077] and [0066]). No new matter is believed to have been introduced.

A substitute sequence listing accompanies the present filing along with the requisite statements. Applicants request entry of the sequence listing into the application.

I. PRIORITY

The Office Action states that Applicants are entitled to the Priority date of April 1, 2004, however, the Office Action alleges that the provisional application filed April 1, 2003, lacks support for the sequences of the instant claims. Applicants respectfully disagree. The provisional application clearly indicates that applicants were in possession of the sequences currently described and claimed. For example, the provisional sets forth the sequence of SCP1 including identification of number of exons at page 34-35, an alignment of a portion of the polypeptide sequence at Figure 1 and a description of the polynucleotide encoding SCP1 at page 8 and 13.

II. OBJECTION TO THE OATH/DECLARATION

The Oath/Declaration is objected to because of the non-dated changes to the addresses for Patrick Lin and Michele Yeo. The Office Action indicates that this objection may be overcome by submitting an Application Data Sheet. Submitted herewith is a substitute Application Data Sheet setting forth the inventors' addresses.

III. OBJECTION TO THE TITLE

The Title has been amended to be more descriptive of the presently claimed invention.

IV. OBJECTION TO THE SPECIFICATION

The specification is objected to for lacking certain sequence identifiers, the use of hyperlinks and reference to “TFIIF” and the “TFIIF” not being defined in the specification.

Applicants have amended the specification to include the sequence identifiers in Table 1 and in the figure description for Figure 1A. The specification has also been amended to remove hyperlinks. Applicants respectfully traverse the objection to the term “TFIIF”. Applicants submit that this is the well known term for the RAP74 subunit.

V. REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-10 stand rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards and the invention. Applicants respectfully traverse this rejection with respect to the amended claims.

Applicants have amended claim 1, upon which the majority of the pending claims depend directly or indirectly to recite hybridization conditions as reflected in the specification at paragraph [0077].

Applicants respectfully traverse the rejection for the term “conservative amino acid substitutions” as set forth in claim 1. Applicants respectfully submit that the specification clearly teaches what a conservative substitution includes. Furthermore, as the Examiner points out, those of skill in the art are familiar with the term and substitution criteria used in the art. It is common practice in the field and before the patent office to use such language and the Recent Written Description Guidelines also include the use of such language (see Example 11 of the Written Description Guidelines – Revision 1, published by the USPTO).

For, at least, the foregoing reasons Applicants believe that this rejection may be properly withdrawn.

VI. REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claims 1 and 5-10 stand rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement. The claims allegedly

contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants respectfully traverse this rejection.

Claim 1 upon which the remaining claims depend directly or indirectly have been amended to set for both structure and function. Accordingly, the claims do not encompass *any* sequence having *any* biological activity. Methods of modification and screening are disclosed in the specification and thus one of skill in the art can readily make and determine whether polypeptides of the invention satisfies the claims without undue experimentation.

For at least the foregoing reasons, Applicants respectfully request withdrawal of this rejection.

VII. REJECTION UNDER 35 U.S.C. §102

Claims 1 and 5-10 stand rejected under §102 as allegedly anticipated by Venter et al. 2002. Applicants respectfully traverse this rejection.

Venter et al. provides a number of sequences, however the sequences do not have a biological activity as described and claimed by Applicants. Venter et al. do not teach or suggest a nucleic acid that encodes a polypeptide having phosphorylation activity or interacts with REST/NESF.

In order for a claim to be anticipated the cited reference must teach each and every element of the claim.

Thus, Venter et al. do not teach or suggest each and every element of Applicants' claimed invention. According, Applicants respectfully request withdrawal of the rejection.

VIII. REJECTION UNDER 35 U.S.C. §103

Claims 1-3 and 5-10 stands rejected under 35 U.S.C. §103 as allegedly unpatentably over Cocks et al. in view of Meinnel et al. Cocks et al. teach a large number of sequences having various translations frames and stop locations. The Cocks et al. patent is a listing of putative sequence that may or may not have activity, that may or may not have start codons and may or may not have stop

codons. SEQ IDNO:843, which is relied upon for the present rejection is a sequence of nearly 2000 basepairs of which only half appear to align and of those that align the start "Met" is missing. Applicants submit that there is not teaching or suggestion in Cocks et al. to providing or identified the sequence set forth by Applicants having the biological activity as set forth in the claims. Cocks et al. fail to teach and suggest each and every element of Applicants' claimed invention (e.g., the actually sequence and the biological activity encoded by the claimed polynucleotide).

In order to overcome the deficiencies of Cocks et al., the Office Action combines Meinnel et al. for the teaching that nearly all proteins begin with an N-terminal Methionine. Applicants submit that Cocks et al. should have been aware of the teachings of Meinnel and thus incorporated an N-terminal Methionine, however, because they did not the indicates that Cocks et al. have a different sequence compare to Applicants. Furthermore, Meinnel et al. indicates that "most" have such a methionine, clearly some do not. Applicants submit that by reasoning, Cocks et al. believed that their sequence was complete based upon the teachings of Meinnel et al. and the proposed combination modifies the reference into something that was chemically and structurally not contemplated and which could have different activity.

Accordingly, Applicants submits that the combination of references fails teach or suggest Applicants' claimed invention.

For, at least, the foregoing reasons the claims submitted herewith are non-obvious over the references either alone or in combination.

For at least the foregoing, the Applicant submits that the claimed invention is patentable and request reconsideration and notice of such allowable subject matter.

The Director is authorized to charge any required fee or credit any overpayment to Deposit Account Number 50-4586, please reference the attorney docket number above.

The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

GAVRILOVICH, DODD & LINDSEY LLP

Date: August 21, 2008

By: /Joseph R. Baker, Jr./
Joseph R. Baker, Jr.
Registration No. 40,900

4445 Eastgate Mall, Suite 200
San Diego, California 92121
(760) 479-0474